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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL H. ROBB

Appeal 2009-004312
Application 09/877,926
Technology Center 3600

Oral Hearing Held: September 9, 2009

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges.*

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on September 9, 2009, at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Timothy J. Atkinson, Free State Reporting, Inc.

PROCEEDINGS

JUDGE CRAWFORD: Good morning.

MS. BOBO-ALLEN: Calendar No. 5, Appeal No. 2009-4312, Mr. Gatto.

JUDGE CRAWFORD: You can begin whenever you're ready.

MR. GATTO: Thank you. Just briefly, I think the invention should be clear, but a couple of points just that maybe tie into the arguments that are raised in the Brief and some of the 112 issues. In the context of the Invention, what this relates to is if you have an individual looking to get financial services, let's say you want to do a will, you may need different financial service advisors, a trust and estate attorney, maybe a CPA, maybe a tax attorney, maybe others who have particular expertise. And so what the invention focuses on is having a client who is receiving advice from different financial advisors, enable them on a case-by-case basis to have access to different documents through a common forum in which those advisors, that team, can collaborate in real time. So everyone can stay -- if you want to update your will, for example, the people who need to know about that who you've preauthorized can be alerted to it, can provide real-time comment and feedback on changes that might be proposed. They can work together on collaborating on documents, et cetera, and the information gets stored in a client centric way with client control over who can access it.

Now the Examiner raises a number of 112 issues, in particular the term participant. The term participant is clearly, I believe, described in the specification in several places as really anyone who participates within a particular client forum. So it could be the client, the financial advisors, et cetera. And what we've tried to do in certain cases there is -- we refer to a

1 financial service participant to make it clear that that's a type of participant
2 for whatever the role is that the claim relates to.

3 The client obviously -- I think it's important here that the client is a
4 person who's receiving advice, okay, so -- and there's numerous places
5 throughout the specification where I believe it's clear that the specification
6 says that you have advisors, clients and other participants which makes clear
7 that participants includes both categories, advisors, clients and others.

8 When we look at the rejection that the Examiner makes under
9 Zucknavich, claim 1, there's two I think real critical problems with that.
10 First of all, Zucknavich is just not even analogous art. Zucknavich if
11 anything is the opposite of what's happening here. In Zucknavich you have
12 an analyst or a -- someone who is researching reports, and they have a
13 number of clients who may pay for access to those reports, all right. And
14 when the research report is issued, and it gets posted to a website, it's the
15 advisor that's providing control over who can access it based on who's paid a
16 subscription fee. So you have one advisor, multiple clients. It's kind of the
17 opposite situation.

18 Additionally what's important is you're not -- that -- even if the
19 research report issuer is an advisor, they're not providing individual advice
20 to the client. It's a common research report that multiple clients can access,
21 and I think where that ties to the claim, what's important is that the claim
22 talks about having client data. The research -- and that's kind of what's
23 being shared and what the collaboration is centered around. In Zucknavich
24 they're -- the research report analyst is writing about stocks. He's not writing
25 about individual clients' financial situations. So you know, I believe in this

1 case we've made a very strong argument that Zucknavich is not analogous
2 art.

3 If you look at the Final Rejection, the Examiner doesn't even allege
4 that Zucknavich relates to the same problems. So if there's going to be
5 analogous art, if the Examiner has demonstrated that's analogous art, it's
6 going to be because it's the same field of endeavor, and I think for the
7 reasons we've set forth in the Brief and as I just touched on, it simply is just
8 not the same field of endeavor. There is really no interaction that occurs
9 between the research report issuer and the many clients who just download
10 that research report, and there's certainly no interaction, no access to client-
11 specific data, et cetera. There really is very little other than the fact that
12 some common words show up in the patent and in the claims. So I think
13 because it's not analogous art, and all of the rejections are premised on
14 Zucknavich to meet the independent claims, we think the rejection clearly
15 failed for at least that reason.

16 Additionally, when you look at -- if you were to consider it under 103,
17 the Examiner admits that Zucknavich doesn't have a common forum. The --
18 which is set forth -- he says that in the Office Action. We'll cite to that in
19 our Brief. But even if you were to somehow get beyond that, there is no
20 client data. When you look at the specific claim elements that are here in
21 claim 1 for example, there just -- there is nothing where a financial advisor
22 accesses client data, and there clearly is no interaction. I mean merely
23 downloading a research report from a website, all right, there is no
24 communication between the people -- the many, many clients who download
25 a research report and the person that issues the report. So you know, for all
26 of these reasons, I think Zucknavich is just so disparate from what the

1 invention is and what the claim recites and what the field of endeavor is that
2 under either basis or both bases the rejection should fail.

3 Lastly, on the 112 issues, I mean I'm happy to address any -- I mean I
4 think these are all plain English terms, collaborate. I've addressed
5 participants. I mean there's several places in the specification, as I
6 mentioned, where it says "advisors, clients or other participants."

7 I think it's clear that there's no problem there. I don't want to bore you with
8 going through all the terms. If there are any terms you'd like me to address,
9 I'd be happy to, but I think they're all pretty much plain English terms and
10 also well described throughout the specification.

11 JUDGE FISCHETTI: I have one question on the 112, is forum, made
12 a part of the rejection on the 35 U.S.C. 112, Second Paragraph Rejection?

13 MR. GATTO: Yes.

14 JUDGE FISCHETTI: Okay. Was that term defined in the spec?

15 MR. GATTO: I don't think there was a formal definition. It was
16 described. I think -- the reason I think that forum was used instead of just
17 website was to highlight the fact that there's, you know, a forum is kind of
18 more of a common meeting place. That's kind of the ordinary meaning, and
19 that's the context in which it's being used here as applied to a web-based
20 tool. All right, so as opposed to a website where you just go and pull
21 information down, the term forum is intended to connote that you have these
22 collaboration tools, document sharing. There's other tools like bulletin board
23 which as I described it -- I mean it's element 422, a chat board 435. And so
24 the term forum is intended to denote a website with more than just you put
25 information up and I pull it down. All right, so there's interactive tools and

1 that's, you know, kind of the context of what forum is intended to mean as
2 you read it throughout the application.

3 JUDGE FISCHETTI: Now interaction, would that cover someone
4 taking a file off the server and reading its contents?

5 MR. GATTO: Well, I think the plain English would say no, but if
6 you look at the claim it's actually more specific than that. One of the things
7 that it says it enables the financial service client to interact with one or more
8 financial service participants. The interaction occurs kind of in real time in
9 different ways. I gave some examples, right, whether you're modifying
10 documents together or engaging in a chat board, whatever. The -- if I post a
11 document and you download it, right, how have I communicated with you?
12 All right, there really is no interaction in the context of how that's used
13 throughout the specification.

14 JUDGE FISCHETTI: It's one-way communication, though.

15 MR. GATTO: One-way communication, but it's different than
16 interaction. Interaction, you know, interactive is -- or interaction or
17 interactive intended to be, you know, kind of connotes two-way, and that's
18 what's used consistently throughout the specification.

19 JUDGE MOHANTY: Mr. Gatto, can I ask you one -- in your
20 definition of forum, like suppose there's a bulletin board, like if you go to a
21 college campus, and sometimes there's a big bulletin board, people just put
22 all kind of flyers up, you know, recycle, there's a music show, is that a forum
23 where people -- do you see what I'm saying? It's --

24 MR. GATTO: That could be a forum, yes. But I think a couple of
25 things are important here, that when you look at the claim elements as a
26 whole, okay, that first of all you enable a team to be defined so that someone

1 is -- if it's an open public, you know, forum, all right, I think even if it's a
2 forum, I'm not sure that that would meet the claim elements. But the --

3 JUDGE MOHANTY: Okay, and why is that? Can you elaborate a
4 little further?

5 MR. GATTO: Well, because first of all, you enable a collaboration
6 team comprising of participants to be defined. So you have defined some
7 team, all right, as disclosed in the spec, that basically the client is saying
8 you're my financial advisors and the specs -- the data can be on a granular
9 basis. So you can allow access to certain documents, not others, et cetera.
10 So you're providing a common forum containing client data, right, where the
11 client data is accessible by financial service providers where each participant
12 has predefined authorizations.

13 Right, in a public bulletin board, right, I mean everyone can come in. They
14 can post whatever they want. You're not posting private data, and you're not
15 preauthorizing who can access that data at any kind of granular level. So
16 even if it is a forum, I think the claim is much more specific than that.

17 JUDGE FISCHETTI: I have one other. How is the client data, at
18 least in terms of your claim, functionally related to the system because you
19 seem to base your argument on the content of that client data versus, for
20 example, Zucknavich's report which would basically be pertinent to the
21 person's financial assets. Seems like you make your distinction on content
22 here. How would you argue around that?

23 MR. GATTO: Well, in the context of the invention, right, if you're
24 receiving financial advice, this is going to be personal, your client, your --
25 the client data is going to be probably sensitive financial data. I think one of
26 the things that's -- as opposed to a research report which is generally public

1 information available about a company. If you look, for example, at the last
2 line of claim 1, you enable interaction through the common forum where the
3 client data is accessible within the scope of access authorized to each
4 participant. Okay, so because of the nature of the data, the nature of what
5 we're dealing with here, right, it's critical that there be -- that the client, right,
6 at least in one embodiment, controls access to the data. And it may not be,
7 as indicated throughout the spec, the access can be different even for
8 different advisors for that client. All right, and so I think this -- when you
9 read it as a whole, right, I think this is part of what makes it clear that it's
10 very different and that the overall tool provides as functionality that serves
11 this purpose, right, which is very different than the purpose in Zucknavich.

12 JUDGE FISCHETTI: No further questions.

13 MR. GATTO: Okay, thank you very much for your time.

14 JUDGE CRAWFORD: Thank you.

15 JUDGE MOHANTY: Thank you.

16 JUDGE FISCHETTI: Thank you.

17 (Whereupon, the hearing concluded on September 9, 2009.)